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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/194,552	03/23/1999	PETER BROOKS	TSRI481.2	3335

7590

01/26/2005

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EXAMINER

HARRIS, ALANA M

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/194,552	Applicant(s) BROOKS ET AL.	
	Examiner Alana M. Harris, Ph.D.	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60,65-84 and 88-108 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 88-108 is/are allowed.
- 6) ☒ Claim(s) 60 and 65-84 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/16/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendments and Arguments

1. Claims 60, 65-84 and 88-108 are pending.

Claim 60 has been amended.

Claims 60, 65-84 and 88-108 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Withdrawn Objection

Claim Objection

3. Claim 60 is no longer objected to because the informality noted in non-final action mailed June 25, 2004 has been amended.

New Grounds of Objection

Claim Objection

4. Claim 88 is objected to because of the following informality: it lists compound numbers. Applicants may obviate this objection by amending the claims to include the structure of the compounds or the full name of the compounds. Correction is required.

Maintained Rejection

Claim Rejections - 35 U.S.C. § 112

5. The rejection of claims 60 and 65-84 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is maintained.

Applicants set forth the criteria governing how the written description requirement may be satisfied. Applicants assert "...that the polypeptides recited in the method of claim 60 do recite sufficient structure to demonstrate to one skilled in the art that the invention was complete at the time the application was filed." Applicants also allege "the written description requirement is fulfilled by the description provided in the specification of the present application because one of skill in the art will recognize that the claims recite sufficient structure to demonstrate that the invention was complete at the time the application was filed.", see Remarks submitted October 26, 2004, page 11, second paragraph. Applicants aver that the transitional term "comprising" is synonymous with "including" and the courts have made it clear that the use of such a term as recited in claim 60 is acceptable to describe the structure of a chemical recited in the method claim and "...the claim is open for the inclusion of unspecified ingredients even in major amounts.", see bridging paragraph of pages 13 and 13 of the Remarks and the first full paragraph. These points of view have been considered, but found unpersuasive.

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First and foremost Applicants' specification continues not to provide sufficient evidence that they were in possession of the infinite number of polypeptides that include the denoted sequences. In essence the sequences are amongst undefined amino acid residues that may exist on the amino- and carboxy- termini of SEQ ID NO: 11-22. Applicants are not in possession of the plethora of polypeptides that comprise the defined sequences of SEQ ID NO: 11-22. Applicants must disclose a representative number of species when claims read on an entire genus. When there is substantial variation with the genus, such as in the instant case one must describe a sufficient variety of species to reflect the variation within the genus, see 1242 Official Gazette 174, January 30, 2001. A genus that embraces widely variant species cannot be achieved by disclosing only one species with the genus. Applicants' claims embody a host of antagonists, which has not been provided within the specification. Applicants seem to only be in possession of $\alpha_v\beta_5$ antagonists consisting of SEQ ID NO: 11-22. Applicants may obviate the instant rejection by deleting the recitation "that includes" and replacing it with the recitation "selected from the group consisting of".

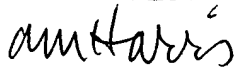
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The examiner works a flexible schedule, however she can normally be reached between the hours of 6:30 am to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571) 272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER


Alana M. Harris, Ph.D.
18 January 2005